

Appl. No. 09/657,956  
Filed 9/8/2000

Atty Docket JP920000170US1

## **REMARKS**

### **1. Posture of the Case**

The case was appealed after a reply to first Office action and a final rejection. No reply brief was issue in response to Applicant's appeal brief. Instead, prosecution was reopened with citation of a new set of art.

The rejection of the broadest claims in the Office action that reopened prosecution relied on Official Notice and a combination of three references, Vatican, Travelocity and Pass. Without amending, Applicant argued in reply that the publication dates of the cited references were not established.

In the present Office action, which finally rejects all claims, additional evidence or arguments are presented regarding publication dates. In addition, a newly cited fourth reference, USP 6092841 ("Best"), is substituted for the Official Notice previously relied upon.

### **2. Applicant's Arguments**

**A. Even if all publication dates are considered to be clearly established in the present Office action, the action has a *new ground for rejection* that is not necessitated by an amendment, so the finality of the present Office action is improper.**

The MPEP unambiguously provides that an action on the merits will not be made final if it includes a rejection on newly cited art of any claim not amended by Applicant. Manual of Patent Examining Procedure ("MPEP") 706.07(a). The present Office action includes such a rejection based on newly cited reference Best. Applicant respectfully submits the final rejection in the present Office action is premature since the claims were not amended in the previous Office action. MPEP 706.07(d) specifically sanctions withdrawing the finality of a rejection if the Primary Examiner determines that a final rejection is premature. Accordingly, Applicant respectfully requests the Patent Examiner and the Primary Examiner to withdraw the finality of the rejection.

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**B. Even if all publication dates are considered to be clearly established in the present Office action, the finality of the rejection in the present Office action is improper because the publication dates were not established in the *previous* action.**

The present Office action contends that Applicant must discuss the references applied therein against the claims, explaining how the claims avoid the references or distinguish from them. However, Applicant is unaware of any authority obligating Applicant to distinguish claims over a reference not properly established as prior art. Neither the previous Office action nor the present Office action cite any authority for such a proposition. It is unfair to burden Applicant with analyzing and discussing references that are not established as prior art. Therefore, Applicant did not previously analyze and discuss such references. Consequently, Applicant was not afforded an opportunity to present arguments explaining how the claims in the present application avoid, or are distinguished from, references that were properly established as *actual* prior art. For this reason, Applicant respectfully submits that the final rejection in the present Office action is premature. Therefore, Applicant respectfully requests the Patent Examiner and the Primary Examiner to withdraw the finality of the rejection in the present Office action.

**C. The finality is also improper because the evidence and arguments *still* do not establish publication dates for all of the references relied upon for the rejections in the present Office action.**

The present Office action continues to maintain that two documents relied upon are actually one, referring to the references collectively as the "Travelocity" reference. However, upon inspection of the documents they clearly are from two different web sites. The first page of the so-called Travelocity reference has a URL as follows:

"<http://archiebonkers.com/Sstorefronts/travelctr.html>" (referred to hereinafter as "Travelocity1").

The next page of the so-called Travelocity reference has a URL as follows:

"<http://travel.travelocity.com/car/CarRequets.do?Service=BF0019861583614302430&SID=>"

(referred to hereinafter as "Travelocity2"). Travelocity1 has no specific publication date, but has a 1999 copyright date, which the Office action relies upon also for Travelocity2.

The Office action offers no evidence whatsoever as to why it follows merely from the fact that a first document having a link to a second document somehow establishes a copyright date of the second document. On the contrary, it is well known that the substance of a document on a

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web site can be changed without changing its URL. Thus, the mere fact that a first document has a hypertext *link* to a second document on the World Wide Web that was established at some certain date does not establish as a fact that the *content* of the second document cannot be updated and thus more recent than the link to the second document that is in the first document. Additionally, it is all the more clear that the one purported fact does not follow from the other, given that the two documents are not even on the same web site. There is no hint of a suggestion that the first web site somehow prevents the second web site from revising its documents.

It is a teaching in Travelocity2 that the Office action relies upon for the rejection. If a publication does not include a publication or retrieval date, it cannot be relied upon as prior art. MPEP Section 2128. Since Travelocity2 does not have a publication date, a retrieval date, or even a copyright date, that precedes the filing date of the present application, it also does not qualify as prior art with respect to the present patent application. Thus, the Office action has *not* established that the teaching relied upon in the so-called Travelocity publication is teaching that is in the prior art.

**D. Even if all publication dates are considered to be clearly established in the present Office action, the combination of references do not teach or suggest the claimed invention.**

In a spirit of cooperation and a desire to expedite an allowance in the present application, and in spite of Applicant's belief that all the references relied upon have not been properly established as prior art and that Applicant has no burden to distinguish claims over such a reference, Applicant herein presents arguments explaining how the claims in the present application avoid, or are distinguished from, the references relied upon for the present rejection, irrespective of whether they are properly established as actual prior art.

1. Vatican does not teach or suggest that an accreditation status is updated in an accreditation system.

The present Office action contends that Vatican teaches updating an accreditation status of a participant in an accreditation system, as claimed in the present application, claim 1. (Claim 5 has similar, "means" language.) However, the cited passage of Vatican merely teaches that a bus or subway ticket "must always be stamped at the beginning of the bus ride or upon entering the subway platform;" that "before the 75-minute expiration, the ticket must be re-stamped in

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order to remain valid for the entire trip;" and that "Validating machines are located on the buses, trams, subway turnstile entrances, Roma-Lido trains and FS trains." Vatican, page 1, line 20 - page 2, line 7. The only obvious implication is that the validating machines are capable of automatically stamping a date and time of day on a ticket. That is, Vatican teaches updating the status of the ticket *using* the validating machine, i.e., by means of the validating machine. There is no teaching or suggestion by Vatican that this includes updating an accreditation status *in* one of the validating machines, where "in" has the sense that the status *exists in the machine*. However, this is clearly the meaning of claim 1 in the present application, particularly given that the claim earlier states information is recorded "*in* [the] accreditation system." Claim 1, step b). Claim 5 has similar language. It would take a tortured and incorrect reading of claim 1 to interpret "updating an accreditation status of the participant *in* the accreditation system" as meaning merely "by means of" the accreditation system.

Moreover, in the phrase "updating an accreditation status of the participant in the accreditation system," the meaning of "in" is informed by the specification, which states, "A non-valid accreditation pass is validated in step 250 by updating the accreditation status of the participant on the accreditation system 300, and laminating the accreditation pass into a security pouch. A validated accreditation pass serves as an identification and access control device to be worn by all participants. Therefore, the validated accreditation pass consists of a *physical part, namely the accreditation pass itself once laminated, and a logical part being the participant's accreditation status, which has been updated on the accreditation system 300.* (emphasis added)" Present application, page 6, line 28 - page 7, line 5.

2. Best does not teach or suggest that laminating is part of a validating step or means.

The lamination taught by Best teaches laminating a promotional mailer to protect printed matter thereon. Best, col. 3, lines 19-21. By contrast, claim 1 of the present application states that securing a pass in a security pouch is part of a "validating" step. (Claim 5 has similar, "means" language, according to an apparatus form of the invention.) Best does not teach or suggest that the laminating is part of a validating step or means.

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3. The rejection of claims 9 and 10 is improper because it does not explain the pertinence of the specific parts of the reference as they relate to the claims.

Applicant contends that the rejection of claims 9 and 10 is improper because the Pass reference, which is relied upon for the rejection, is complex and describes inventions other than that claimed by Applicant, and the Office action merely contends that certain paragraphs of the reference apply but does not explain the pertinence of the specific parts of the reference as they relate to the claims. 37 CFR 1.104 (c)(2); MPEP 707. Applicant is unable to respond fully to the rejection without an explanation of how the Examiner relates the reference to the claims in the present application. Applicant is unable to find any description in the cited passage about first and second portions of a non-valid pass, where non-valid passes issued to participants form a first portion, and wherein non-valid passes are produced by an accreditation system for organisations, such a non-valid pass for an organisation forming a second portion of a valid pass. Nor is Applicant able to find any teaching in the cited passage about issuing the non-valid passes to said organisations, so that the organisations may distribute the second portions to selected ones of the participants associated with the respective organisations, wherein the validating uses both the first and second portions of the pass.

**E. There is no suggestion or motivation for the combination.**

1. Vatican and Travelocity do not have a compatible principle of operation.

If a combination of prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. MPEP 2143.01 (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). There is no teaching or suggestion that the "validating machines" of Vatican are the sort of machines that include information recorded in them that is collected from a participant, whereas this is the type of accreditation system that is claimed and that the Office action relies upon for the teaching of claim 1, step b), for example. (Claim 5 has similar, "means" language, according to an apparatus form of the invention.) That is, the present Office action points to a type of system in Travelocity in which information about a customer is collected and recorded in the system, and then changes the principle of operation of the accreditation system, pointing to a type of machine in Vatican in which the machine updates an accreditation status by merely placing a time stamp on a ticket, not by updating a status recorded in the system. For this

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reason, no proper motivation or suggestion has been shown for the combination of Vatican and Travelocity.

2. No proper motivation or suggestion has been shown for the combination of the laminating taught by Best and the teachings of Vatican, Travelocity and Pass.

While some of the references relied upon may be suitable for combining, this does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)). The Office action contends that, Vatican, Travelocity and Pass relate to transportation systems. Office action, page 3, item 9 and page 4, item 12. While Applicant questions whether Travelocity is related to a transportation system, even setting this aside, the references do at least relate to the issue of transportation. However, the fourth reference relied upon, Best, does not even relate to the same topic as the other three references, much less the topic of the present application. According to the present patent application, "The present invention relates generally to accreditation and, in particular, to accreditation of participants involved to an event." 1/6-7. Merely passing mention is made of transportation. Present application, page 3, lines 23-24. ("They include access rights to one or more access-controlled zones or venues, and rights to use transport and meal facilities."); and page 5, lines 17-24 ("The passes may contain the following information . . . Entitlements (such as food, transport seating access)."). Best concerns a coupon card disposed within a promotional mailer. Best, col. 1, lines 13-16.

It is important to rely on objective evidence and make specific factual findings with respect to the motivation to combine references. MPEP 2143.01 (citing *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002)). "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." MPEP 2143.01 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998)). Regarding the teachings of the prior art, the teachings must do more than merely show all aspects of the claimed invention were individually known in the art. MPEP 2143.01 (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993), and indicating there must be an objective reason to combine the teachings of the references). Regarding the nature of the problem to be solved, such motivation might exist in the nature of the problem to be solved if each reference is directed "to

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precisely the same problem.” MPEP 2143.01 (citing *In Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, at 1276 (Fed. Cir. 2004)). Regarding the knowledge of persons of ordinary skill in the art, it has been held that without a finding about a “specific understanding or principle within the knowledge of the skilled artisan” that would have provided a motivation combine the teachings, alleged knowledge of persons of ordinary skill in the art provided no motivation to combine. MPEP 2143.01 (citing *In re Kotzab*, 217 F.3d 1365, at 1370-1371, (Fed. Cir. 2000)).

It is unclear which source of motivation the Office action contends is applicable to the combination of Best with Vatican, Travelocity and Pass. Certainly, the nature of the problem to be solved is not directed to precisely the same problem in Best as in the other three references. The Office action cites no objective reason or specific understanding or principle within the knowledge of the skilled artisan taught by Best that would have provided a motivation to combine teachings about validating a pass for transportation and protecting printed material in a promotional mailer. Even granting the benefit of the doubt, and assuming that protecting printed material in a promotional mailer by laminating the surface of the mailer suggests *protecting* a transportation pass by laminating the pass, this still does not explain a motivation to combine a teaching by Best about laminating a coupon and teachings about a *validating* step or means, whereas the combination claimed in the present invention concerns securing a pass in a security pouch as *part of a validating step or means*. Moreover, the issue of transportation itself, i.e., the subject of Vatican, Travelocity and Pass is tangential to the subject matter of the present invention. For these reasons, Applicant contends no proper motivation or suggestion has been shown for the combination of the teachings of Best and those of Vatican, Travelocity and Pass.

### **PRIOR ART OF RECORD**

Applicant has reviewed the prior art of record cited by but not relied upon by Examiner, and asserts that the invention is patentably distinct.

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### **REQUESTED ACTION**

Applicant hereby requests the following actions:

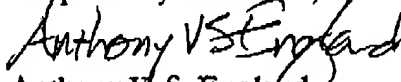
1. For the above reasons, Applicant contends the invention in claims 1 and 5 is patentably distinct. Further, claim set 2-4 and 9 and set 6-8 and 10 are allowable at least because they depend on respectively allowable independent claims. MPEP 2143.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious," citing *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Applicant requests that Examiner reconsider the final rejection and grant allowance and prompt passage of the application to issuance.

2. Due to the impropriety of the final rejection in the present Office action, if the Examiner is still not persuaded by arguments presented herein that the claims are allowable over the references currently relied upon, Applicant requests an advisory action withdrawing the finality of the rejection in the present Office action and indicating that a new Office action will be issued responsive to the present reply, setting a new period for reply to the new Office action. Applicant acknowledges that in a proper case the new Office action may be final, since Applicant has herein presented arguments explaining how the claims in the present application avoid, or are distinguished from, the references relied upon for the present rejection, irrespective of whether they were properly established as actual prior art. It would *not* be properly final, however, if the new Office action includes a rejection on newly cited art of any claim not amended by Applicant or a rejection based on art that is not properly established as actual prior art.

3. If the claims are not allowed and reliance upon the Pass is maintained, Applicant respectfully requests that the new Office action properly set out the specific parts of the Pass reference relied upon for the rejection and an explanation of the *pertinence of the specific parts*.

4. Applicant encourages the Examiner to contact Attorney England if needed.

Respectfully submitted,



Anthony V. S. England  
Attorney for Applicants  
Registration No. 35,129  
512-477-7165  
a@aengland.com